

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Claims 1-3, 5-6, and 8-15 are now pending.

As noted in the Request to Vacate Official Action filed June 10, 2003 and the supplemental remarks filed September 9, 2003, from the Examiner's Action it appears that rather than using the application text filed by applicant on September 18, 2000, the U.S. Patent Office file in this case was created from the parent PCT application text, as would be done for a U.S. National Phase application. It is believed that the filing of June 10, 2003, in particular as supplemented by the filing of September 9, 2003 clearly establishes that the text asserted to be filed by applicant (including 15 numbered claims and no multiple dependent claims) was in fact the text filed and not the original PCT application text.

Although the request for a new action was very promptly filed on June 10, 2003, and although in response to a voicemail inquiry on July 10, 2003, the Examiner confirmed receipt of the June 10, 2003 letter and advised that the case was in the Examiner's docket to work on [a new action], a decision on the request of June 10, 2003 has not yet been received. Furthermore, the undersigned was advised on September 9, 2003 that in spite of the alleged incompleteness of the first Official Action, a response to that Office Action was due unless and until a decision was issued on the June 10, 2003 request. Since no decision has yet been received in this matter, a response to the Examiner's Official Action is provided herein. Because the Action was issued in error and should have been timely withdrawn, applicant hereby reserves the right to request a refund of the two-month extension fee required with this response upon receipt of a favorable decision in regard to the June 10, 2003 Request. All amendments presented hereinabove are amendments relative to the PCT text that the Examiner is apparently considering, to bring them into the form in which they were filed in this continuation and also to add claims 4 and 7 to claim 1. Claims 8-14 which were presented by the

undersigned when this application was filed have been re-introduced above. Claim 15, which was also presented in the as-filed application has been presented in independent form above.

The Examiner acknowledged applicant's claim for priority "based upon an application filed in Germany on May 23, 1997, but asserted that a claim for priority in this case cannot be based on that application since the U.S. application was filed more than 12 months thereafter. The Examiner is respectfully advised that applicant does not claim priority to the German application in this case. The Examiner was advised of the German application because the Rule 63 Declaration must list any (related) foreign applications for patent that were filed before the current application whether or not priority is claimed, in the interest of full disclosure.

The Examiner required that reference to the international application under 35 USC 120 be presented in the first sentence of the specification. Actually, this application as filed included the required statement, but the as-filed application text was apparently lost within the U.S. Patent Office and the PCT text, which did not include the required statement, was apparently substituted therefor by PCT branch personnel. In the event the text asserted to be filed by applicant is not reintroduced as the application text, the PCT text used by the Examiner has been amended above to include the required statement. As the priority claim under 35 USC 120 was clearly indicated in the filing request and recognized and accepted by the Patent Office as evidenced from the filing receipt and the office action, no petition or fee is required in connection with this amendment to the specification.

Claims 4-7 were objected to under 37 CFR 1.75(c) as being in improper form. The claims filed with this application by the undersigned on September 18, 2000 included no multiple dependencies. It is understood, however, that because the Examiner considered only the PCT claims, improper multiple dependencies were presented in the text the Examiner considered. Accordingly, the claims have been revised above so that the claims correspond to the as-filed claims, so as to remove any multiple dependencies. Reconsideration and withdrawal of this rejection are requested.

Claim 1 was rejected under 35 USC 102(b) as being anticipated by Meade et al. (USP '035). Further, claims 2 and 3 were rejected under 35 USC 103(a) as being unpatentable over Meade et al. in view of Tomita et al. ('164). Applicant respectfully traverses these rejections.

Anticipation under Section 102 of the Patent Act requires that a prior art reference disclose every claim element of the claimed invention. See, e.g., Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1574 (Fed. Cir. 1986). While other references may be used to interpret an allegedly anticipating reference, anticipation must be found in a single reference. See, e.g., Studiengesellschaft Kohle, G.m.b.H. v. Dart Indus., Inc., 726 F.2d 724, 726-27 (Fed. Cir. 1984). The absence of any element of the claim from the cited reference negates anticipation. See, e.g., Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 715 (Fed. Cir. 1984). Anticipation is not shown even if the differences between the claims and the prior art reference are insubstantial and the missing elements could be supplied by the knowledge of one skilled in the art. See, e.g., Structural Rubber Prods., 749 F.2d at 716-17.

In order to prove obviousness, a challenger must present prior art references which disclose the claimed subject matter of the patent/application in question. If separate prior art references each disclose separate elements of a claim, the challenger must also show some teaching, suggestion, or incentive in the prior art that would have led one of ordinary skill in the art to make the claimed combination. See, e.g., Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297 n.24, 304-05 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). In determining obviousness, there must be some reason other than hindsight for selectively combining the prior art references to render the claimed invention obvious. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143 (Fed. Cir. 1985).

It is submitted that claim 1 as amended hereinabove and claim 9 (which as noted above was originally filed, but not provided to the Examiner by applications branch) are not anticipated by nor obvious from Meade.

The device of the present invention is an electrostatically controlled device and comprises a rotary diffuser disc for transmission of material from a supply system to a pair of bell-shaped members. The diffuser disc has at least one aperture therethrough so that some of the material supplied by the supply system can pass through the aperture and on to an external face of the rotary diffuser disc. The material is then forced centrifugally towards an outer bell shaped member.

Meade discloses a spray device with counter rotating inner and outer runners. Material to be atomised passes through the inner runner before atomising on impact with teeth of the outer runner. The inner runner has a disc shaped portion at its end but there are no apertures provided in this disc portion to allow material to pass through the inner runner and on to an external face of the inner runner. Further, Meade appears to disclose a conventional sprayer with no mention of the device being electrostatically controlled.

The provision of at least one aperture through the diffuser disc in the present invention has been found to be particularly advantageous. The aperture allows the provision of two fluid paths to the bells which in turn can lead to better control of the curtain of particles leaving the device. Where the material to be transmitted is paint there can be a further advantage in that as material flows along the surface of the disc from the aperture to the outer bell-shaped member a drying process can begin which can aid in the final paint finish.

For the reasons advanced above it is respectfully submitted that claims 1, 9 and 15 are not anticipated by nor obvious from Meade et al. The Examiner's further reliance on the secondary reference to Tomita does not overcome the deficiencies of the primary reference noted above.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited.

STRATTON et al.
Appl. No. 09/744,664
October 23, 2003

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:

A handwritten signature in black ink, appearing to read "Michelle N. Lester", written over a horizontal line.

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